

## REMARKS

Applicants acknowledge receipt of an Office Action dated July 11, 2008. In this response, Applicants have amended claim 1. Following entry of this amendment, claims 1 and 5-9 remain pending in the application. Claims 7 and 8 have been withdrawn from consideration. Thus, claims 1, 5, 6, and 9 are currently pending and under consideration.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

### **Rejection Under 35 U.S.C. § 112, Second Paragraph**

On page 2 of the Office Action, the PTO has rejected claims 1, 5, 6, and 9 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite. In this response, Applicants have amended claim 1 to delete the term “film thickness.”

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 112, second paragraph.

### **Rejections Under 35 U.S.C. § 103**

On page 2 of the Office Action, the PTO has rejected claims 1, 5, and 9 under 35 U.S.C. § 103(a) as being allegedly unpatentable over EP 0148718 to Panush (hereafter “Panush”) in view of U.S. Patent 6,291,018 to Dattilo (hereafter “Dattilo”), and further in view of U.S. Patent Publication 2004/0028823 to Dutt (hereafter “Dutt”). In addition, on page 4 of the Office Action, the PTO has rejected claim 6 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Panush in view of Dattilo, and further in view of U.S. Patent 5,962,574 to Jackson *et al.* (hereafter “Jackson”). Applicants respectfully traverse these rejections for at least the reasons set forth below.

The framework for the objective analysis for determining obviousness under §103 requires:

1. Determining the scope and content of the prior art;
2. Ascertaining the differences between the claimed invention and the prior art;
3. Resolving the level of ordinary skill in the pertinent art; and
4. Considering objective evidence present in the application indicating obviousness

or nonobviousness.

*Teleflex, Inc. v. KSR Int'l Co.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

Here, Panush, Dattilo, Dutt and Jackson, whether taken individually or in combination, fail to teach or suggest a method “wherein the clear paint coating is a transparent coating and does not contain a color pigment” as recited in claim 1.

Panush is directed to a “substrate material coated with at least two layers of polymer including a base coat ... and a transparent topcoat comprising a pigmented thermosetting.” Panush, page 2, lines 3-5. Panush actually teaches away from the presently claimed invention, and thus is not an appropriate reference under § 103(a). Panush discloses “a final total coating system which is *much stronger than a system with an untinted clear coat.*” Panush, page 7, lines 51-52 (emphasis added). The clear coating of Panush is a “color tinted clear coat [that] significantly reduces the penetration of solar energy and moisture, providing an intermediate that absorbs, reflects, and refracts solar energy and moisture ... and result[s] in lower and reduced ultraviolet rays reaching the base coat.” Panush, page 7, lines 53-61. A person of skill in the art would not modify the method disclosed in Panush, which specifically states that a system with an untinted clear coat is much stronger, to incorporate a clear paint coating that “is a transparent coating and does not contain a color pigment” as presently claimed.

Dattilo teaches “[a]pplying the effect pigment-containing second basecoat layer over the first basecoat layer ... permit[s] the effect pigment in the second basecoat layer to correctly orient. Dattilo, Col. 9, lns. 3-9. However, Dattilo fails to teach or suggest a method “wherein the clear paint coating is a transparent coating and does not contain a color pigment” as recited in claim 1.

Dutt discloses that the tinted clear coat can be replaced “with a regular untinted clear coat.” Dutt, Para. [0022]. However, this does not cure the deficiency of the base reference Panush, which teaches away from the presently claimed invention.

Jackson discloses a “sprayable, solvent-borne, primer composition ... overcoated wet-on-wet with automotive topcoat finishes and cured simultaneously in a single bake.” Jackson, Abstract. However, Jackson fails to teach or suggest a method “wherein the clear paint coating is a transparent coating and does not contain a color pigment” as recited in claim 1.

For at least these reasons, Applicants submit that the outstanding rejections based upon the combination of Panush, Dattilo, Dutt, and Jackson do not properly apply to the currently pending claims and ought to be withdrawn.

If an independent claim is nonobvious under § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP 2143.03. Thus, Applicants submit that claims 5, 6, and 9, each of which ultimately depends from independent claim 1, are also non-obvious at least by virtue of their dependency from claim 1.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under § 103.

### CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

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Respectfully submitted,

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